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FACSIMILE TRANSMITTAL SHEET

TO: **Examiner John J. Gillon, Jr.** FROM: **Joseph Skerpon**
c/o Beverly Orlebar, Assistant to Joseph Skerpon

COMPANY: **USPTO** DATE: **May 21, 2004**

OFFICE OF PETITIONS

FAX NO.: **703-305-4257** TOTAL NO. OF PAGES: (including cover sheet) **9**

OUR REFERENCE (C/M) NO. **6385.00001**

RE: **U.S. Application No. 09/878,860**

If you do not receive all page(s) or have any problems receiving this transmission, please call:

NAME: **Beverly Orlebar** PHONE: **202-824-3125**

COMMENTS:

Dear Mr. Gillon,

As requested in our telephone conversation on May 21, 2004, attached is the Entry of Final Agency Action with the stamp receipt postcard indicating it was filed in the USPTO on March 12, 2004. Mr. Skerpon will be in the office on Monday, May 24, 2004.

Sincerely,
Beverly Orlebar
Assistant to Joseph M. Skerpon

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application Of:) Group Art Unit: 3711
George Michael MOCKRY et al.) Examiner: M. Chambers
Serial No.: 09/878,860)
Filed: May 10, 2002) Attorney Docket No.: 006385.00001

For: **METHOD OF RECORDING AND PLAYING BASEBALL GAME SHOWING
EACH BATTER'S LAST PITCH**

**REQUEST FOR RECONSIDERATION
AND
ENTRY OF FINAL AGENCY ACTION
IN CONNECTION WITH PETITION
FOR CORRECTED FILING DATE**

Office of Petitions:

Attention John J. Gillon, Jr.
Commissioner of Patents
Washington, D.C. 20231

Sir:

This is a request for reconsideration of a decision (Paper No. 21 – dated November 21, 2003) dismissing applicants' renewed petition requesting that the subject application be accorded a filing date of June 9, 2001.

In the event that the decision is adhered to, applicants also request that the decision be made final so that applicants can seek redress by way of civil action in a court of proper jurisdiction.

Prompt consideration of this request also is requested. The subject application has been allowed and the deadline for paying the issue fee in this application is May 24, 2004.

Atty. Docket No. 006385.00001

Applicants' undersigned representative requests that any fee that may be required pursuant to 37 C.F.R. §§1.17(h) or otherwise in order to consider this request for reconsideration be charged to our Deposit Account No. 19-0733. To the extent applicants may later be entitled to a refund of any fee so-charged, it should be credited to our Deposit Account No. 19-0733.

The underlying petition was filed under 37 C.F.R. 1.181(a)(2) and pursuant to 37 C.F.R. 1.53(e)(2). In that petition, applicants sought a determination of their entitlement to a filing date of June 9, 2001, the date that the inventors fully complied with 37 C.F.R. 1.53(b) by filing in accordance with 37 C.F.R. 1.10, a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75.

REASON FOR RECONSIDERATION/POINTS OVERLOOKED

In the decision, one critical fact in the sequence of events was completely overlooked, as was applicants' primary argument in support of their entitlement to the June 9, 2001 filing date for their application. Indeed, a statement in the decision indicated that the Renewed Petition "addresses no new issues." We submit that this statement is patently incorrect. The earlier petitions did not address the significance of the Official Filing Receipt of December 2001 and of the relevant portions of MPEP §503 relating to the issuance of a Filing Receipt.

KEY FACTS NOT MENTIONED IN THE DECISION:

Following June 9, 2001, the date on which the "application was deposited," an official Filing receipt was issued by the United States Patent and Trademark Office dated December 20, 2001. That Filing Receipt identified the application number 09/878,860 and accorded that application a filing date of June 9, 2001. (MD2¶11-Exhibit 6).¹ That Filing Receipt also identified the Group Art Unit of the application as 3711, acknowledged the claim to benefit of the previously filed Provisional Application 60/211,208 and granted a foreign filing license to

¹ Citations in this request for reconsideration are to documents appended to the original Renewed Petition filed September 9, 2003. Reference to MD1¶1 refers to paragraph 1 of the first declaration of George Mockry filed with the first petition (a copy of that declaration was submitted as Attachment A to the Renewed Petition and has been annotated with paragraph numbers). Citation to MD2¶1 refers to paragraph 1 of the second declaration of George Mockry first filed with the Renewed Petition as Attachment B. The referenced Exhibits refer to the Exhibits attached to the second Mockry declaration and the Renewed Petition itself.

Atty. Docket No. 006385.00001

the application as of December 20, 2001. (MD2 – Exhibit 6). It was not until almost three months later, on March 15, 2002, that the Office of Initial Patent Examination (OIPE) then mailed a Notice of Incomplete Nonprovisional Application to the inventors. (Exhibit D).

KEY ARGUMENT TOTALLY IGNORED

MPEP §503 makes the issuance of a filing receipt by the USPTO *prima facie* evidence of compliance with Rule 53(b).

MPEP §503 states unequivocally:

OIPE mails a filing receipt to the attorney or agent, if any, otherwise to the applicant, for each application which meets the minimum requirements to receive a filing date. (Emphasis added)

The filing receipt represents the official assignment by the USPTO of a specific application number and confirmation number to a particular application. See 37 CFR 1.54(b). (Emphasis added)

...as between inconsistent filing receipts and postcard receipts, the application number on the filing receipt is controlling.

The filing receipt will be mailed at the time a determination is made that the application meets the minimum requirements to receive a filing date. (Emphasis added)

Here, a filing receipt was mailed to applicants in December 2001, long prior to the date the Office issued the Notice of Incomplete Application in March 2002. Based on the USPTO's own rules, the complete application, thus was received and processed by OIPE. It was not until after that date that the USPTO apparently lost the application.

Thus, as of December 20, 2001, the USPTO confirmed that Mockry had filed papers that

Atty. Docket No. 006385.00001

met the minimum requirements for the application to receive a filing date – that is a written description and at least one claim were provided. In the absence of satisfying those requirements, the filing receipt never should have issued. It was not until sometime after confirming the proper filing of the application that the USPTO apparently lost applicants' written specification.

Unless the USPTO is going to assume that it did not comply with a pair of its own regulations (including both the issuance of the filing receipt and the handling of the return postcard) and thus ignore the long accepted principal of administrative regularity, the facts of this case demand the conclusion that a written description was received and processed by the USPTO following the filing of the application on June 9, 2001.

As demonstrated by the previously filed Mockry declarations and the Renewed Petition, that application was identical to Mockry's earlier filed Provisional application. It was only after the issuance of the December 2001 filing receipt that the USPTO somehow misplaced that application. When viewed together, that December 2001 filing receipt, which acknowledges the claim to priority to the earlier provisional application by both serial number and filing date, together with the postcard receipt and the Mockry declarations, present a coherent and persuasive picture confirming that the original two page provisional application constituted the written description filed on June 9, 2001.

We submit that the USPTO should be bound by its own rules and must accept its own actions and provide the subject application with the original June 9, 2001 filing date.

ADDITIONAL POINTS

The decision seems to attach great significance to the fact that the post card also did not identify the priority information (Provisional Application filing number or filing date). Aside from the fact that the PTO's rules do not require that information on the post card, papers accompanying the post card, which the PTO does not deny receiving, DID contain that information. Indeed, the issuance of the Official Filing Receipt in December 2001 is but further irrefutable evidence on that point. We submit that when the complete picture of actions by both applicant and the Office is considered, the unmistakable conclusion is that the inventors fully

Atty. Docket No. 006385.00001

complied with 37 C.F.R. 1.53(b) by filing, in accordance with 37 C.F.R 1.10, a specification as prescribed by 35 U.S.C. 112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75.

Second, the decision ignores the provisions of MPEP §503, requiring that once the Patent Office received the application papers:

The person receiving the item(s) in the USPTO will check the listing on the postcard against the item(s) being filed to be sure they are properly identified and that all items listed on the postcard are presently being submitted to the USPTO. If any of the items listed on the postcard are not being submitted to the USPTO, those items will be crossed off and the postcard initialed by the person receiving the items.

In this case, Mockry received the return postcard with NOT A SINGLE ITEM indicated as missing. The only logical conclusion is that all of the listed items were received and processed by the OIPE.

CONCLUSION

When the record and action of the USPTO are viewed as a whole, one is left with the unmistakable conclusion that the USPTO accepted the June 9, 2001 filing of the original provisional application, which applicant has testified he filed, as the specification of the subsequent nonprovisional application and generally acted consistent with that acceptance, save for the wrongful issuance of the Notice of Incomplete application.

Applicants simply ask that common sense not be left out of the reconsideration of the petition and any review of their actions and the supporting documentation.

Applicants thus request reconsideration of their request that the subject application be accorded a filing date of June 9, 2001, the date that the inventors fully complied with 37 C.F.R. 1.53(b) by filing in accordance with 37 C.F.R 1.10, a specification (in this case an identical copy of their earlier provisional application) as prescribed by 35 U.S.C. 112 containing a description pursuant to §1.71 and at least one claim pursuant to §1.75. Again, in the event that the request

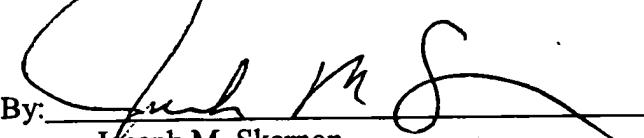
Atty. Docket No. 006385.00001

relief is denied, applicants request that the petition be denied as FINAL AGENCY ACTION, allowing them a right to seek *mandamus* writ in the proper court.

Respectfully submitted,

BANNER & WITCOFF, LTD.

By:


Joseph M. Skerpon
Registration No. 29,864

Date: March 12, 2004

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JMS/

PTO/SB/21 (05-03)

Approved for use through 04/30/2003. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

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TRANSMITTAL FORM

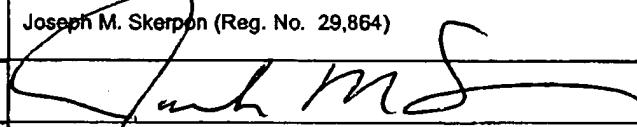
(to be used for all correspondence after initial filing)

TRANSMITTAL FORM <i>(to be used for all correspondence after initial filing)</i>		Application Number	09/878,860
		Filing Date	May 10, 2002
		First Named Inventor	George Michael MOCKRY et al.
		Art Unit	3711
		Examiner Name	M. Chambers
Total Number of Pages in This Submission	1	Attorney Docket Number	006385.00001

ENCLOSURES (check all that apply)

<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment / Response <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Response to Missing Parts/ Incomplete Application <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Assignment Papers <i>(for an Application)</i> <input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input checked="" type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____	<input type="checkbox"/> After Allowance Communication to Group <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input type="checkbox"/> Appeal Communication to Group <i>(Appeal Notice, Brief, Reply Brief)</i> <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) <i>(please identify below):</i> Postcard
Remarks		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

Firm or Individual name	Joseph M. Skerpon (Reg. No. 29,864)
Signature	
Date	March 12, 2004

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below.

Typed or printed name			
Signature		Date	

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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